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BAKER + HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

CECIL, TERRY K

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 12/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,169

Applicant(s)

DRUGA, LARRY A.

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 15-20, drawn to a fluid filter/dual direction bypass valve, classified in class 210, subclass 130.
 - II. Claims 13-14, drawn to method of preventing clogging of a fluid which flows through a filter, classified in class 210, subclass 767.
2. The inventions are distinct, each from the other because of the following reasons:
 - Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of Invention I can be used in a different process, e.g. one in which bypass valves open to relieve excessive pressure surges that could damage the filter (taking place before the fluid is clogged within the filter as in the process of Invention II). It is also pointed out that apparatus does not require that the filter be installed "backwards".
3. Restriction for examination purposes is proper because of the reasons given above and also because (i) they have acquired a separate status in the art as shown by their different classification, (ii) the search required for the respective groups is not necessarily required by each of the other groups, and (iii) their subject matter is recognized as divergent.

4. During a telephone conversation with William Lewis on 12-6-2002 a provisional election was made with traverse to prosecute invention I, claims 1-12 and 15-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to because of the following reasons:

- figure 3 is missing; and
- in figure 4, the leader of reference no. "129" doesn't indicate the disk (as explained on page 7 of the specification).

Applicant is required to submit a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Objections to the drawings will not be held in abeyance.

Priority

6. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Claim Rejections - 35 USC ' 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-2, 6-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected because of the following reasons:

- In claims 1, 2, 6, 7 and 12, the phrase “a first retainer which houses a first spring *at one end*, and a first disk disposed at *another end* of said first spring” it is unclear if the “at one end” and “at another end”

- (i) both refer to the ends of the retainer or

- (ii) both refer to the ends of the spring or

- (iii) refer to one end of the retainer and one end of the spring.

For examination purposes, the phrase is taken to mean: “a first retainer housing an end of a first spring, said first spring having another end disposed at a first disk.” The same rejection applies for the “second retainer” phrase in the claims.

- The following terms lack antecedent basis: “said front valve body” and “said rear valve body” (both in claim 8).
- Claim 9 is rejected since it suffers the same defects as claim 8 from which it depends.

Claim Rejections - 35 USC ' 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper (U.S. 3,996,137). Cooper discloses a fluid filter that clearly anticipates claims 3 and 4. The bottom of figure 2 thereof is reproduced below.

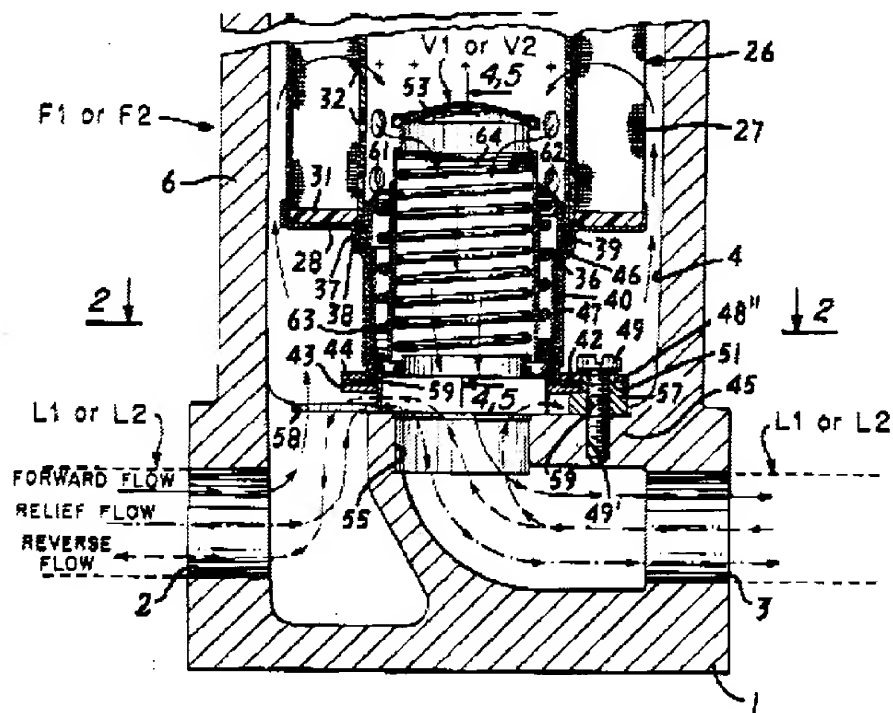


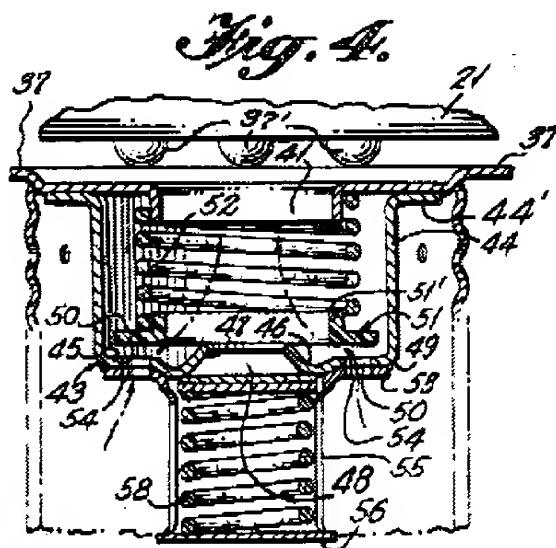
FIG. 2

The first, second, third fluid flows and the arrows thereof are shown above as the forward flow, relief flow, and reverse flow, respectively [as in claim 3], wherein the first flow path includes the

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inlet 2, the space between the filter element 27 and the housing 6, the filter element, a central passage 35, and the outlet 3 [as in claim 4].

11. Claims 1-9, 11-12 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by ~~Hultgren~~ (U.S. 3,000,506). As shown in figure 4 reproduced below, ~~Hultgren~~ clearly anticipates claim 1.



As shown above, Hultgren discloses a first retainer 44 (or alternately 37 and attached wall 34), a first spring, a first disk 51, a second retainer 55, a second spring, and a second disk 57 (see figure 2), wherein the disks are operative to compress in opposite directions toward their respective retainers [as in claim 1].

In addition, as shown in figure 1, Hultgren teaches the aforementioned dual direction bypass valve in combination with a filter 33 having an inlet and an outlet (12 or 13) and an end cap

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separating the first and second disks (bottom portion 45 can be viewed an end cap between disks 51 and 57 and the retainer—37 and attached wall 34) [as in claim 2].

Hultgren also discloses a first fluid flow path (shown in figure 1), a second fluid flow path allowing a forward flow bypass means (shown in figure 2); and a third fluid flow path allowing a reverse flow bypass means (shown in figure 4) wherein the reverse flow bypass means is disposed adjacent the forward flow bypass means [as in claim 3].

As shown in figure 1, in the first fluid flow path, fluid entering inlet 12 flows through apertures 32 in the first retainer (37 with attached wall 34) into a space between the filter element 33 and wall 34 (which is also between the filter media and an interior face of a central wall of the chamber), through the filter media 33 into a central passage and out the outlet 13 [as in claims 4 and 5], wherein the spring 30 is considered a stabilizing spring that is disposed between the first retainer and the housing which results in holding the first retainer in place [as in claim 11].

As shown in figure 4, Hultgren also discloses the reverse flow bypass means to include a first disk 51 against a plurality of peripheral holes 50 in the end cap 45 operable to open toward the first retainer means (37) for fluid to bypass the media [as in claim 6].

As shown in figure 2, Hultgren also discloses the forward bypass means to include a second disk 57 against a central opening 48 in the end cap 45 operable to open toward the second retainer means 55 to bypass the filter media [as in claim 7], wherein the forward flow bypass means (the

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second fluid flow path) leads through the front valve body (that includes 44) and through the rear valve body (that includes 55) to the outlet 13 [as in claim 8] and the reverse bypass means (third flow path) leads from outlet 13 through the central passage, front valve body (via holes 50) to bypass the rear valve body (including 55) and the media [as in claim 9].

As for claims 12 and 15-18, Hultgren, as expanded above, anticipates all the limitations thereof.

As for claims 19 and 20, the drawing symbol for disk 51 (alternating diagonal thin and thick lines) indicates the disk is made of plastic [as in claim 19] and the drawing symbol for the retainer, spring and end cap (diagonal thin lines) indicates the elements are made of metal. See MPEP 608.02.

Claim Rejections - 35 USC ' 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

- Determining the scope and contents of the prior art.
- Ascertaining the differences between the prior art and the claims at issue.
- Resolving the level of ordinary skill in the pertinent art.
- Considering objective evidence present in the application indicating obviousness or nonobviousness.

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13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper in view of Gizowski (U.S. 6,139,737). Cooper has been expanded above and teaches all the limitations of claim 3. Claim 10 has the limitation of a magnet positioned around a side wall of an interior face of the chamber, which attracts and retains magnetically susceptible particles in the fluid. Gizowski teaches such a magnet: 18 of figure 2. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the magnetic of Gizowski in the filter of Cooper since Gizowski teaches the benefit of removing metal particles that may damage mechanical components of a vehicle (col. 1). Such a benefit is also desired by Cooper (col. 1, lines 55-62). Since fluid in both prior art references flows between the housing and the filter element before being filtered, such a structural modification is possible.

14. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
 - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
 - ii. (703)872-9311 if after-final.

TKC
December 6, 2002

Examiner Terry K. Cecil
A.U. 1723